

Customer No.: 31561  
Application No.: 10/064,490  
Docket No.: 9766-US-212

### REMARKS

#### **I. Present Status of the Application**

The Office Action made the following objections and rejections: (1) Claims 1, 2, 7 and 8 are rejected under 35 U.S.C. § 112, ¶ 1, as based on a disclosure which is not enabling, claims 6 and 7 are rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite; (2) claims 5 and 6 are objected to under 37 CFR 1.75(c) because of multiple dependency; (3) claims 1 and 2 are rejected under 35 U.S.C. § 102(a) as being anticipated by JP 08-232174; (4) under 35 U.S.C. § 103(a) as being unpatentable, claims 1 and 4 are rejected over Lasman et al. (4,017,656) in view of Katabe et al. (US 4,515,852), claim 4 is rejected over JP 08-232174 in view of Lasman et al., claim 3 is rejected over JP 08-232174 as evidenced by Nishibayashi et al. (US 3,939,021), claim 3 is rejected over Lasman et al. in view of Katabe et al. as evidenced by Nishibayashi et al., claims 7 and 8 are rejected over JP 08-232174 as evidenced by Higgs et al. (US 3,661,674), and claims 7 and 8 are rejected over Lasman et al. in view of Katabe et al. as evidenced by Higgs et al.; and (5) claims 1-4 are rejected under doctrine of obviousness-type double patenting as being unpatentable over claims 6-10 of US Patent No. 6,114,260.

Upon entry of the amendments in this response, claims 1-3, and 6-7 are currently amended, claims 10-12 are newly added, and claim 5 is canceled. Claim 9 was previously withdrawn. Hence, claims 1-4, 6-8 and 10-12 remain pending in the present application, with claims 1-2 being independent claims. Claim 1 is amended based on the original claim 1

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incorporating with the limitation recited in the original claim 5, claim 2 is amended based on the original claim 1 incorporating with the limitation recited in the original claim 5. Claim 5 is canceled while the limitation recited thereof is incorporated into claims 1 and 2. Claim 6 is added, and claims 10 and 11 are added based on the original claim 6. Amendment of claim 7 and addition of claim 12 are based on the original claim 7. Applicant believes that the foregoing amendments do not introduce new matter. Thus, reconsideration of those claims is respectfully requested.

## **II. Response to Objections and Rejections**

### **A. Rejections under 35 U.S.C. 112**

The Office Action, at page 2, items 3 and 5, rejected claims 1, 2, 7 and 8 under 35 U.S.C. § 112, ¶ 1, as based on a disclosure which is not enabling, and rejected claims 6 and 7 under 35 U.S.C. § 112, ¶ 2, as being indefinite. Applicant respectfully traverses the rejections as applied to the amended claims.

Regarding claims 1, 2, 7 and 8, the Examiner stated "the porous layer made of an open-cell foam is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure." While respectfully disagreeing with the Examiner's statement, Applicant nevertheless amended the independent claims 1 and 2 in a manner to expedite prosecution of this application.

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Regarding claim 6 (upon the amendment, the relevant claims are claims 6 and 10-11), the Examiner stated that "the unit of the specific gravity is missing." It is respectfully submitted that "specific gravity" is an expression of a relative value, which carries no unit by definition. In the Merriam-Webster Dictionary, "specific gravity" is defined as "the ratio of the density of a substance to the density of some substance (as pure water) taken as a standard when both densities are obtained by weighing in air" (emphasis added).

Regarding claim 7, the phrase "or the like" renders the claim indefinite. Applicant deleted the phrase "or the like" by amending claim 7 and adding a dependent claim 12.

Therefore, Applicant respectfully submits that the grounds of rejections have been addressed and the rejections overcome. Reconsideration and withdrawal of the rejections are respectfully requested.

**B. Objections to the claims**

The Office Action, at page 3, item 6, objected claims 5 and 6 under 37 CFR 1.75(c) because a multiple dependent claim 5 depends from another multiple dependent claim 4. Upon entry of the amendments, claim 5 is canceled while the limitation recited thereof is incorporated into claims 1 and 2. Applicant respectfully submits that this ground of objection has been addressed and the objections overcome. Reconsideration and withdrawal of the objection are respectfully requested.

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**C. Rejections under 35 U.S.C. § 102(b)**

The Office Action, at page 3, item 8, rejected claims 1 and 2 under 35 U.S.C. § 102(a) as being anticipated by JP 08-232174. Applicant respectfully traverse the rejection as applied to the amended claims for at least the reasons set forth below.

To anticipate a claim, the reference must teach each and every element of the claim. M.P.E.P. § 2131.

The amended claim 1 or 2 provides a sheet structure comprising a peelable transfer sheet, a film layer, and a porous layer formed on the film layer, and further recites a limitation that "a thermally-fused open-cell foamed layer formed on the porous layer."

However, JP 08-232174 does not teach the above-mentioned limitations recited in the amended claim 1 or 2, even though JP 08-232174 teaches certain elements (abstract; [0016], [0018]; Figs. 1-4) of the subject matter recited in the original claims 1 and 2. Therefore, JP 08-232174 does not anticipate claim 1 or 2, as amended, since JP 08-232174 does not disclose each and every element of the claims.

Accordingly, Applicant respectfully submits that the grounds of rejection have been addressed and the rejection overcome. Reconsideration and withdrawal of the rejection is respectfully requested.

**D. Rejections under 35 U.S.C. § 103(a)**

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The Office Action, at pages 4-7, items 9-15, rejected the following claims under 35 U.S.C. § 103(a) as being unpatentable: Claims 1 and 4 are rejected over Lasman et al. (4,017,656) in view of Katabe et al. (US 4,515,852), claim 4 is rejected over JP 08-232174 in view of Lasman et al., claim 3 is rejected over JP 08-232174 as evidenced by Nishibayashi et al. (US 3,939,021), claim 3 is rejected over Lasman et al. in view of Katabe et al. as evidenced by Nishibayashi et al., claims 7 and 8 are rejected over JP 08-232174 as evidenced by Higgs et al. (US 3,661,674), and claims 7 and 8 are rejected over Lasman et al. in view of Katabe et al. as evidenced by Higgs et al. Applicant respectfully traverses the rejection as applied to the amended claims.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claimed limitations. M.P.E.P. § 2143.

Regarding claims 1 and 4 over Lasman et al. in view of Katabe et al., the Examiner states that it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the transfer sheet having a convexo-concave shape reverse to a leather like convexo-concave surface motivated by the desire to decrease the slipperiness on the surface of the leather-like sheet material. Applicant respectfully disagrees with the Examiner's statement as applied to the amended claims 1-4 for at least the reasons set forth as below.

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Lasman et al.'s imitation leather material differs from that recited in claims 1-4 at least in that Lasman et al. do not disclose "a thermally-fused open-cell foamed layer formed on the porous layer." Katabe et al. disclose that "[m]any attempts have been made to decrease slipperiness on the surface of the known leather-like sheet materials," and one method is "embossing large concave and convex emboss pattern onto the surface of leather-like sheet materials" (column 1, lines 43-46). However, Katabe et al. immediately teach away from the method by asserting the following in the same paragraph: "However . . . the leather-like sheet-materials which are given such particular emboss pattern have a defect . . .," and "[t]hus, the known methods are never sufficient to decrease slipperiness on the surface" (column 1, lines 50-63).

At least due to the above-mentioned teaching away by Katabe et al., one of ordinary skill in the art would not have been motivated to employ the method of embossing concave and convex emboss pattern onto the surface of leather-like sheet materials. There is no reasonable expectation of success to combine Katabe et al.'s teaching to what taught by Lasman et al. Even if such a combination were made, due to the different teaching of Lasman et al., the resulting structure would have been still significantly different from that of the claimed invention. Therefore, the amended claims 1-4 are non-obvious over Lasman et al. in view of Katabe et al.

Regarding claim 4 over JP 08-232174 in view of Lasman et al., the Examiner stated that Lasman discloses the process of making the porous layer as set forth in the claim, which

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providing the necessary detail to practice the invention of JP 08-232174. Applicant respectfully disagrees with the Examiner's statement as applied to the amended claim 4.

As discussed in the foregoing subsection II.C, JP 08-232174 does not teach the limitation that "a thermally-fused open-cell foamed layer formed on the porous layer" recited in the amended claims 1 and 2. Since claim 4 at issue is dependent on either claim 1 or 2, JP 08-232174 does not teach the above-mentioned limitation inherited by claim 4 from the base claim 1 or 2, and thus the sheet structure of JP 08-232174 is significantly different from that of claim 4. Therefore, even if Lasman et al. teach the process of making the foam layer, the combination of the prior art references could not provide the necessary detail to improve the invention of JP 08-232174 to produce the results recited in claim 4.

Regarding claim 3 over JP 08-232174 as evidenced by Nishibayashi et al., the obviousness rejection is traversed based on at least the reason similar to that mentioned in the paragraph above. Similar to claim 4, claim 3 at issue is dependent on either claim 1 or 2. JP 08-232174 does not teach the aforementioned limitation inherited by claim 3 from the base claim 1 or 2, and thus the sheet structure of JP 08-232174 is significantly different from that of claim 3. Therefore, even if Nishibayashi et al. teach the cell size of the porous layer, the combination of the prior art references could not provide the necessary detail to improve the invention of JP 08-232174 to produce the results recited in claim 3.

Regarding claim 3 over Lasman et al. in view of Katabe et al. as evidenced by Nishibayashi et al., Applicant respectfully traverses the obviousness rejection as applied to the

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amended claims. As mentioned earlier in this subsection, claims 1 and 4 are non-obvious over Lasman et al. in view of Katabe et al. at least for that Lasman et al. do not disclose "a thermally-fused open-cell foamed layer formed on the porous layer," and for that Katabe et al. teach away from the concave and convex emboss pattern. Therefore, even if Nishibayashi et al. teach the cell size of the porous layer, there would not have sufficient suggestion or motivation to one of ordinary skill in the art to employ Nishibayashi et al.'s porous layer having a cell size instantly claimed and the method of embossing concave and convex pattern, which is taught away by Katabe et al., to improve Lasman et al.'s leather-like sheet material and achieve the results like that of claim 3.

Regarding claims 7 and 8 over JP 08-232174 as evidenced by Higgs et al. and over Lasman et al. in view of Katabe et al. as evidenced by Higgs et al., Applicant respectfully traverses the rejections based on at least the claims' dependency on claim 1 or 2, and similar reasons as above-mentioned in this subsection.

Therefore, claims 1, 3-4 and 7-8 are not obvious over the cited prior art references. Accordingly, for at least the foregoing reasons, Applicant respectfully submits that the grounds of rejection have been addressed and the rejection overcome. Reconsideration and withdrawal of the rejection are respectfully requested.

**E. Double patenting rejection**



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The Office Action, at page 7, item 17, under the judicially created doctrine of obviousness-type double patenting, rejected claims 1-4 as being unpatentable over claims 6-10 of U.S. Patent No. 6,114,260 (hereinafter "the '260 patent") issued to the Applicant. Applicant respectfully traverses the rejection as applied to the amended claims 1-4 of the present application.

The amended claims 1-2 and claims 3-4 dependent thereupon of the application provide a sheet structure comprising a peelable transfer sheet, a film layer, and a porous layer formed on the film layer, and further recite a limitation that "a thermally-fused open-cell foamed layer formed on the porous layer." The open-cell foamed layer is used, for example, to enhance flexibility of the sheet structure (specification, at page 5, lines 4-6). However, claims 6-10 of the '260 patent do not provide the limitations of the "open-cell foamed layer" that is recited or inherited in the amended claims 1-4 of the application, even though claims 6-10 of the '260 patent recite a sheet structural material comprising a supporting fabric, a porous layer formed on the supporting fabric, and a film layer formed on the porous layer.

Therefore, to one of ordinary skill in the art, claims 1-4 of the present application are significantly distinguishable from claims 6-10 of the '260 patent, such that none of claims 1-4 of the present application defines the invention that is merely an obvious variant of the invention recited in claims 6-10 of the '260 patent.

Accordingly, Applicant respectfully submits that the rejection has been overcome and should be withdrawn. Reconsideration and withdrawal of the rejection are respectfully requested.

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**CONCLUSION**

For at least the foregoing reasons, it is believed that the pending claims 1-4, 6-8 and 10-12 are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

Respectfully submitted,

Date :

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